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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,370	06/02/2006	Paul Hansen	7744P002	9736

8791 7590 08/15/2007  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
1279 OAKMEAD PARKWAY  
SUNNYVALE, CA 94085-4040

EXAMINER
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WONG, LUT

ART UNIT	PAPER NUMBER
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2129

MAIL DATE	DELIVERY MODE
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08/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,370	<b>Applicant(s)</b> HANSEN ET AL.	
	<b>Examiner</b> Lut Wong	<b>Art Unit</b> 2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is responsive to an AMENDMENT entered May 25, 2007 for the patent application 10/561370.

The First Office Action of Feb 23, 2007 is fully incorporated into this Final Office Action by reference.

### ***Status of Claims***

Claims 1-14, and 27 are pending. Claims 1, 5-14, and 27 have been amended.

### ***Specification***

The abstract of the disclosure is objected to because the phrase "a decision support method comprising: for two or more pre-defined criteria and one or more pre-defined and ordinally ranked categories for each criterion" is confusing with multiple "and". It is also not clear from the phrase what the method is supposed to do.

The phrase "a method for determining a point value for each category on each criterion by ordinal pairwise ranking of profile pairs, wherein each profile comprises two or more of the criteria, each criterion associated with one of the categories for that criterion" is also confusing.

The Examiner can barely concluded from the abstract that it is a decision support method with ordinal ranking of profiles.

Correction is required. See MPEP § 608.01(b).

***Response to Arguments***

In re pg. 18-19, Applicant's arguments with respect to drawing and claim objections have been fully considered and are persuasive. The previous objections have been withdrawn.

***Claim Objections***

Claims 14 and 27 are objected to because of the following informalities:

Claim 14 recites "A decision support system comprising: two or more pre-defined criteria stored in a data memory, each...". The Examiner contends that criteria is not a physical component of the system. As such, the criteria should not be recited in the claim body.

Claim 27 is objected for the same reason as claim 14.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 recites "for two or more pre-defined criteria and one or more pre-defined and ordinaly ranked categories for each criterion, and for two or more profiles, each profile comprising a set of two or more of the criteria and each criterion in the set

associated with one of the categories for that criterion" in the preamble. The phrase is confusing with multiple "and". It is also not clear from the phrase what the requirement is in the preamble.

Claim 1 recites the limitation "comprises the ordinal pairwise ranking of profile pairs". There is insufficient antecedent basis for this limitation in the claim. There is no mention of "ordinal pairwise ranking" before that.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title,

**Claims 1-14, 27 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-14 and 27 are rejected under 35 U.S.C 101 because the claims fail to provide a concrete result. Particularly, claims 1, 14 and 27 recites "receiving from the decision maker an ordinal pairwise ranking of the profiles". The Examiner contends that the decision receive from the decision maker lacks concreteness. I.e. given same

profiles to the same decision maker, the pairwise ranking can be different. Hence, the result are based on subjective criteria, and not repeatable.

Claims 1-14 and 27 are also rejected under 35 U.S.C 101 because of preemption. Neither the claims nor the spec limit the invention to any practical application. First of all, there is no practical application recited in the claim. Second of all, the spec gives open ended examples of practical applications (See spec p.9), which is unbounded. Third of all, applicant's remark (See pg. 21) also admits unbounded list of applications. As such, the Examiner can reasonable conclude from the above evidence that the claimed invention is preempting the idea.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-14, 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hansen et al (WO 2004/111906 A1).**

Claims 1-14, 27 are drawn to a decision support method that performing a ordinal pairwise ranking of profile pairs by a decision maker and solving a system of

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qualities/inequalities that represents the ordinal pairwise rankings to obtain a point value or rankings.

Applicant's PCT publication anticipates all the claimed limitations because 1) this application is a 371 of PCT/NZ04/00121 filed 06/14/2004 and published on 12/23/2004. 2) The filing date of national stage is 6/02/2006, which is more than 18 months from the PCT filing date. As such, applicant cannot claim the PCT filing date as the effective filing date. Hence, the WIPO publication is published 1 year prior to U.S filing date, which is a valid 102(b) reference. 3) Since this application is a 371 of PCT/NZ04/00121, all the limitations have to be taught in the WIPO publication, otherwise applicant cannot claim the priority. Since applicant claims the priority, all limitations are taught.

### ***Claim Rejections - 35 USC § 103***

#### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### ***Citation of pertinent prior art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Behnam Malakooti ("Ranking and Screening Multiple Criteria Alternatives with Partial Information and Use of Ordinal and Cardinal Strength of Preference" IEEE 2000)

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

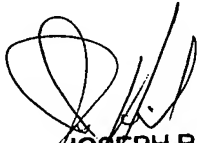
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lut Wong/  
Patent Examiner, AU 2129



JOSEPH P HIRL  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100